

ESTTA Tracking number: **ESTTA450155**

Filing date: **01/09/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Kickz AG
Granted to Date of previous extension	01/07/2012
Address	Feilitzstrasse 1 Munich, 80802 GERMANY
Domestic Representative	Timothy R DeWitt 24IP Law Group USA, PLLC 12 E Lake Dr Annapolis, MD 21403 UNITED STATES tdewitt@24ipusa.com Phone:4102122539

### Applicant Information

Application No	85373939	Publication date	11/08/2011
Opposition Filing Date	01/09/2012	Opposition Period Ends	01/07/2012
Applicant	INC International Company 143 Viburnum Drive Kennett Square, PA 19348 UNITED STATES		

### Goods/Services Affected by Opposition


Class 025. All goods and services in the class are opposed, namely: Running shoes
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### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3188433	Application Date	02/01/2002
Registration Date	12/26/2006	Foreign Priority Date	NONE
Word Mark	K1X		

Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: Clothing, namely, shoes, hats, caps and t-shirts</p> <p>Class 028. First use: Gym and sports articles and sports devices for training improvement, namely, basketballs, dumb-bell shafts, running machines, rowing machines for physical exercise (other than for medical use), knee guards (sports articles), bar bells, batting gloves (accessories for games), belt vibrators, abdomen protectors (parts of sports suits), sport supporters (for wrist, knee, elbow, ankle, neck and spine), dumb-bells, baseballs, baseball gloves, baseball bat cases, baseball batting gloves, baseball masks, baseball mitts, baseball bats, baseball bases, chest protectors (for baseball), weight lifting machines, weight lifting gloves, weight lifting belts (sports articles), rosin used by athletes, bicycle training wheels, stationary exercise bicycles, rollers for stationary exercise bicycles, chest expanders (sports articles), gymnastic and training stools, horizontal bar (for gymnastics), benches for exercises, spring boards (for gymnastics), vaulting horses (for gymnastics), rings for gymnastics, soccer balls, chinning bars, balance beams (for gymnastics), parallel bars (for gymnastics), home bases, American footballs</p> <p>Class 035. First use: Advertising, namely, dissemination of advertising matter, rental of advertising space, merchandising services, namely, product merchandising, marketing services, namely, direct marketing advertising for others, conducting marketing studies; distribution services, namely, distributorship in the field of clothing, sporting goods</p> <p>Class 041. First use: Performing housefairs for cultural or educational purposes, namely, conducting entertainment exhibitions in the nature of sport festivals; conducting sports tournaments in the field of basketball, baseball, American football, golf, tennis, and soccer; entertainment in the nature of basketball games and baseball games</p>		

U.S. Registration No.	1523564	Application Date	02/13/1987
Registration Date	02/07/1989	Foreign Priority Date	NONE
Word Mark	KIX		

Design Mark	
Description of Mark	THE MARK CONSIST OF "KIX" WITH A WAVE DESIGN.
Goods/Services	Class 025. First use: First Use: 1986/01/31 First Use In Commerce: 1986/03/05 SYNTHETIC BEACH SANDALS

Attachments	76366454#TMSN.gif ( 1 page )( bytes ) 73644404#TMSN.gif ( 1 page )( bytes ) 4091-20001USW6NoticeofOpposition.pdf ( 6 pages )(124845 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/timdewitt/
Name	Timothy R DeWitt
Date	01/09/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KICKZ AG	)	
	)	
Opposer,	)	Opposition No. _____
	)	Serial No. 85/373,939
v.	)	Mark: KIXX
	)	Filing Date: July 18, 2011
INC INTERNATIONAL COMPANY	)	Publication Date: November 8, 2011
	)	
Applicant.	)	
	)	

**NOTICE OF OPPOSITION**

Kickz AG, a German Corporation, located and doing business at Feilitzstrasse 1, Munich 80802, Germany, (hereafter called “Opposer”), believes that it will be damaged by the registration of the mark shown in Application Serial No. 85/739,939 in International Class 25 for the mark KIXX filed by INC International Company, a Pennsylvania corporation, (hereinafter “Applicant”) on July 18, 2011, and opposes Application Serial No. 85/739,939.

The grounds for the opposition are as follows:

1. Commencing long prior to Applicant's filing date, Opposer has engaged, and Opposer is now engaged in the manufacture, distribution, *sale*, advertising and promotion in interstate commerce of a wide range of shoes.

2. Commencing long prior to Applicant's filing date, Opposer has used, and Opposer is now using Opposer's K1X trademark in connection with shoes.

3. Opposer, is owner of, and will rely herein, upon the following Federal Trademark registrations:

Mark	Registration No.	Issue Date	Goods
K1X	3,188,433	12/26/2006	Class 25: clothing, namely, shoes, hats, caps and t-shirts

			<p>Class 28: gym and sports articles and sports devices for training improvement, namely, basketballs, dumb-bell shafts, running machines, rowing machines for physical exercise (other than for medical use), knee guards (sports articles), bar bells, batting gloves (accessories for games), belt vibrators, abdomen protectors (parts of sports suits), sport supporters (for wrist, knee, elbow, ankle, neck and spine), dumb-bells, baseballs, baseball gloves, baseball bat cases, baseball batting gloves, baseball masks, baseball mitts, baseball bats, baseball bases, chest protectors (for baseball), weight lifting machines, weight lifting gloves, weight lifting belts (sports articles), rosin used by athletes, bicycle training wheels, stationary exercise bicycles, rollers for stationary exercise bicycles, chest expanders (sports articles), gymnastic and training stools, horizontal bar (for gymnastics), benches for exercises, spring boards (for gymnastics), vaulting horses (for gymnastics), rings for gymnastics, soccer balls, chinning bars, balance beams (for gymnastics), parallel bars (for gymnastics), home bases, american footballs.</p> <p>Class 35: advertising, namely, dissemination of advertising matter, rental of advertising space, merchandising services, namely, product merchandising, marketing services, namely, direct marketing advertising for others, conducting marketing studies; distribution services, namely, distributorship in the field of clothing, sporting goods.</p> <p>Class 41: performing house fairs for cultural or educational purposes, namely, conducting entertainment exhibitions in the nature of sport festivals; conducting sports tournaments in the field of basketball, baseball, American football, golf, tennis, and soccer; entertainment in the nature of basketball games and baseball games.</p>
KIX and design	1,523,564		Class 25: Synthetic beach sandals

Opposer's Registered Marks are, in all respects, valid, subsisting and owned by Opposer and are conclusive evidence of Opposer's exclusive right to use such marks in commerce on the goods specified in said registration.

4. Opposer's mark K1X (Reg. No. 3,188,433) is similar to Opposer's mark KIX and design (Reg. No. 1,523,564) and Applicant's mark KIXX. While Opposer's mark K1X (Reg. No. 3,188,433) does not contain the lettering "I", the use of the numeral "1" appears similar to an "I" in the typed form of the mark. Additionally, since Opposer's mark K1X (Reg. No. 3,188,433) is registered in the typed form of the mark, Opposer may use the mark in any stylized form. Consumers view the mark K1X (Reg. No. 3,188,433) to be the wording "KIX" because it is a familiar arrangement of letters and is the phonetic equivalent of the word "KICKS." The fact that Opposer's name is "KICKZ AG", the phonetic equivalent of "KIX," reinforces the impression that the mark K1X is similar to KIX and KIXX.

5. In addition to Opposer's Registered Marks specified above, Opposer shall rely herein upon its common law usage of its K1X mark in connection with various products, including use on athletic shoes distributed in interstate commerce. Together, such registered and common law uses comprise a valuable family of trademarks, collectively known as "Opposer's K1X Marks."

6. Opposer has made substantial investment in advertising and promoting their goods under Opposer's K1X Marks since their initial use. Opposer has extensively used, advertised, promoted and offered Opposer's goods bearing Opposer's K1X Marks to the public through various channels of trade in commerce with the result that Opposer's customers and the public in general have come to know and recognize Opposer's K1X Marks and associate the same with Opposer and/or goods sold by Opposer.

7. As a result of the aforesaid advertising, promotion and sales, Opposer's K1X Marks are famous and distinctive and became famous and distinctive well prior to the filing of this application and/or well prior to the Applicant's actual use or intended use of the alleged mark.

8. Upon information and belief, notwithstanding Opposer's rights in and to Opposer's K1X Marks, on July 18, 2011, Applicant filed an application under Application Serial No. 85/373,939 for registration of the proposed mark KIXX in standard form for "running shoes" in International Class 25.

9. Applicant's KIXX Mark so resembles Opposer's K1X Marks as to be likely to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

10. Opposer, upon information and belief, avers that its customers, and the public generally, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's proposed goods to be marketed under Applicant's alleged KIXX Mark and misled into believing that such goods, emanate from, or are licensed by or are in some way directly or indirectly associated with Opposer, to the detriment of Opposer and its reputation. Opposer therefore opposes the mark under the Trademark Act Section 2(d).

11. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the alleged KIX Mark, as set forth in Applicant's Trademark Application Serial No. 85/373,939, in that the Applicant's mark and Opposer's K1X Marks are both dominated by the initial letter "K" and the final letter "X" with the strikingly similar "1" and "I" in between, are applied to closely related or identical goods.

12. Opposer, upon information and belief, also avers that it will be damaged by the registration by Applicant of the proposed KIXX Mark, as set forth in Applicant's Trademark Application Serial No. 85/373,939, in that the alleged mark will dilute the distinctiveness of Opposer's famous K1X Marks within the meaning of the provisions of the Federal Trademark Dilution Act of 1995, as amended by the Trademark Revision Act of 2006. Wherefore, this Opposer, Kickz AG, believes and avers that it is being and will continue to be damaged by registration of the Applicant's proposed KIXX Mark as aforesaid, and prays that said Application

Serial No. 85/373,939 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

24IP LAW GROUP USA, PLLC



By: \_\_\_\_\_

Timothy R. DeWitt  
Registration No. 35,857

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Date: January 9, 2012



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KICKZ AG	)	
	)	
Opposer,	)	Opposition No. _____
	)	Serial No. 85/373,939
v.	)	Mark: KIXX
	)	Filing Date: July 18, 2011
INC INTERNATIONAL COMPANY	)	Publication Date: November 8, 2011
	)	
Applicant.	)	
	)	

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Notice of Opposition has been served on the following attorney of record and correspondence for INC International Company as listed on the TARR database of the United States Patent and Trademark Office by mailing said copy on January 9, 2012, via First Class Mail, postage prepaid to:

Matthew H. Swyers  
The Trademark Company  
Suite 151  
344 Maple Avenue West  
Vienna VA 22180



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Timothy R. DeWitt